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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,817	01/15/2002	Richard Allen Brown	214967	4741

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EXAMINER	
JIANG, SHAOJIA A	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,817	BROWN, RICHARD ALLEN	
	Examiner	Art Unit	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-9,11-32 and 52-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-9, 11-32, and 52-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to Applicant's amendment and response filed on May 27, 2005 wherein claims 1-4, 6-9, 11-32, and 52-58 have been amended; claim 5, 10 and 33-51 are cancelled previously.

Currently, claims 1-4, 6-9, 11-32, and 52-58 are pending in this application.

Claims 1-4, 6-9, 11-32, and 52-58 as amended now are examined on the merits herein.

Applicant's declaration of Richard A. Brown (inventor), submitted May 27, 2005 under 37 CFR 1.132, is acknowledged and will be further discussed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-9, 11-32, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenbery et al. (US 5,143,722, of record) in view of Collin et al.(US 5656672, PTO-892) and Guthauser (US 5162378, of record).

Hollenbery et al. discloses cosmetic or make-up (i.e., a foundation, eyeliner) compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in amount about 30%, an aqueous phase for example 26% of water by weight which reads about 30%, a pigment herein and a sunscreening agent such as titanium dioxide (TiO2), an emulsifier broadly having HLB value from 2 to 12 in 0.25-2% by wieght, such as the surfactant therein (see col.6 lines 13-45) and a thickener such as quaternium-18 hectorite (see col.6 lines 60-67) in amount for example 0.5% by weight, an inorganic salt such as sodium chloride, and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane i.e., cyclomethicone in amount 22.6% for example, prooylene glycol, and a preservative such as propyl paraben (see abstract, col.1-2, col.6 lines 11-68, Example 1-6 at col.7-8, and claims 1-15).

Hollenbery et al. does not expressly disclose the employment of the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions therein. Hollenbery et al. does not expressly disclose the inherent property of the composition which is stable for at least three months at about 50^0C.

Collin et al. discloses a water-in-oil emulsion composition for personal care comprising an oil phase which is present in amount from 10-50% by weight of said composition (see col.2 lines 46-19), an aqueous phase which is present in amount from 50-90% by weight of said composition (see col.2 lines 50-52), an emulsifier such as cetyl dimethicone copolyol (also known as "ABIL EM-90"), 0.5-10% or preferably 1-6% by weight (see col.3 lines 40-47) or **3%** in Example 2 and 4 at col.5-6, inorganic salts

such as NaCl, 0.6-0.7% in Examples. See also claims 1-23. Collin et al. also discloses the emulsion is stablized for at least two months at **45^{0}C** (see abstract).

Guthauser discloses a water-in-oil emulsion composition for personal care comprising 8-20% of the particular emulsifier, cetyl dimethicone copolyol, having known HLB value from 4 to 6 (see abstract, col.2 lines 30-39, and claim 1 in particular), 20-40% of water, 10-35% of silicone elastomer herein such as cyclomethione and phenyl dimethicone, 8-20% of inorganic salts, and 1-20 % of PEG (see claims 1-4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Hollenbery et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular emulsifier, cetyl dimethicone copolyol, in the water-in-oil emulsion compositions of Hollenbery et al, since an emulsifier broadly having HLB value from 2 to 12, is known to be used in the water-in-oil emulsion composition according to Hollenbery. The particular the particular emulsifier, cetyl dimethicone copolyol, is known to have HLB value from 4 to 6 according to Guthauser. More importantly, the similar water-in-oil emulsion composition for personal care of Collin et al. is known to employ an emulsifier such as cetyl dimethicone copolyol in 0.5-10% or preferably 1-6% or **3%** by weight.

Thus, an emulsifier, cetyl dimethicone copolyol in 0.5-10% or preferably 1-6% or **3%** by weight is known and art-recognized which can provide the HLB value as the water-in-oil emulsion composition of Hollenbery et al. desired to give water-in-oil

emulsion. Therefore, one of ordinary skill in the art would have reasonably expected that a known and art-recognized emulsifier, cetyl dimethicone copolyol, having HLB value from 4 to 6, in 0.5-10% or preferably 1-6% or **3%** by weight would have the same or substantially similar usefulness as other emulsifiers therein in water-in-oil emulsion compositions of Hollenbery et al, based on the disclosure of Collin et al. and Guthauser.

Moreover, it has been well settled that recitation of an inherent property of a composition, which is stable for at least three months at about 50^0C in claim 1, will not further limit claims drawn to a composition, so long as the prior art discloses the same or similar or obvious composition comprising the same or similar or obvious ingredients in an effective amount as the instantly claimed.

Further, Collin et al. discloses a water-in-oil emulsion composition for personal care comprising an oil phase which is present in amount from 10-50% by weight of said composition, an aqueous phase which is present in amount from 50-90% by weight of said composition (see col.2 lines 50-52), an emulsifier such as cetyl dimethicone copolyol (also known as "ABIL EM-90"), 0.5-10% or preferably 1-6% by weight or **3%** in Example 2 and 4 at col.5-6, inorganic salts such as NaCl, 0.6-0.7% in Examples; this composition or emulsion is stablized for at least two months at **45^0C**.

It must be recognized that any judgment on obviousness takes into account knowledge which was generally available and within the level of ordinary skill at the time the claimed invention was made. Knowledge of those skilled in art and nature of problem solved provided motivation and made obvious a combination of elements -- Princeton Biochemicals, Inc. v. Beckman Coulter, Inc. 04-1493 -- On June 9, 2005,

recently the Federal Circuit upheld a finding of obviousness of Princeton's capillary electrophoresis device, used to separate proteins and other matter. This court upheld that motivation to combine the elements came from the knowledge of those skilled in the art and the nature of the problem solved by the invention.

Response to Argument

Applicant's arguments filed May 27, 2005 with respect to the rejection of claims 9-16 made under 35 U.S.C. 103(a) as being unpatentable over Hollenbery et al. (US 5,143,722) in view of Collin et al.(US 5656672) and Guthauser (US 5162378) in the previous Office Action December 1, 2004 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art.

Applicant argues that "[w]ith no motivation for one of ordinary skill in the art to combine the disclosures of Hollenberg et al., Collin et al., and Guthauser, claims 1-4, 6-9, 11-32, and 52-58 are unobvious". These remarks are believed to be adequately addressed by the obvious rejection presented above.

In particular, it must be recognized that any judgment on obviousness takes into account knowledge which was generally available and within the level of ordinary skill at the time the claimed invention was made. Knowledge of those skilled in art and nature of problem solved provided motivation and made obvious a combination of elements -- Princeton Biochemicals, Inc. v. Beckman Coulter, Inc. 04-1493 -- On June 9, 2005, recently the Federal Circuit upheld a finding of obviousness of Princeton's capillary

electrophoresis device, used to separate proteins and other matter. This court upheld that motivation to combine the elements came from the knowledge of those skilled in the art and the nature of the problem solved by the invention.

In this case, the motivation to combine the teachings of the prior art cited herein, to make the present invention is seen since these references have provided knowledge of those skilled in art and nature of problem solved. In particular, the teachings of Collin et al.,i.e., the water-in-oil emulsion composition for personal care and the stability thereof, has provided knowledge of those skilled in art and nature of problem solved. The claimed invention is clearly obvious in view of the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-9, 11-32, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al. (US 5,599,533, of record) in view of Rapaport (US 5730991, of record) and Dorogi et al. (US 5882661, of record).

Stepniewski et al. discloses cosmetic compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in the instant amount (see col.2 line 56 to col.3 line 18), an aqueous phase in the instant amount (see col.4 lines 55-58), a pigment herein, vitamin A and E, a sunscreening agent broadly and pigments broadly such as titanium dioxide (TiO2) and a preservative (see col. 4 line 4 to col.5 .line 7), an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight (see col.2 lines 29-35), or the particular emulsifier or surfactant, **cetyl dimethicone copolyol** in 0.5% by weight (see col.4, line 27-28 and col.5 Example 1) and a thickener such as such as quaternium-18 hectorite in the instant amount (col.3 lines 45-65 and col.4 line 4), and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane in the instant amount, i.e., cyclomethicone (see col.2 lines 19-45), prooylene glycol and an inorganic salt such as sodium chloride (see col.3 lines 51-61). See also abstract, Example 1-6 at col.5-6, and claims 1-40.

Stepniewski et al. does not expressly disclose the employment of an emulsifier comprising a cetyl dimethicone copolyol in 3-6% by weight, the particular sunscreening agent herein and the particular preservative herein in the water-in-oil emulsion compositions therein. Stepniewski et al. does not expressly disclose the inherent property of the composition which is stable for at least three months at about 50^0C.

Rapaport discloses that octyl methoxycinnamate is well known sun screening agent. See col.17 lines 20-25, col.19 line 10.

Dorogi et al. discloses that phenoxyethanol, propyl paraben and methyl paraben are preferred preservatives therein used in personal care or conditioning human skin, hair or nails compositions (see col.5 lines 17-18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ an emulsifier comprising a cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Stepniewski et al., and to employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine or optimize an emulsifier comprising a cetyl dimethicone copolyol in 3-6% by weight, since an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight is known according to Stepniewski et al. More importantly, the particular emulsifier or surfactant, **cetyl dimethicone copolyol** in 0.5% by weight is used in the particular emulsion example therein (see col.5 Example 1). Thus, **cetyl dimethicone copolyol** in 0.5% by weight used in the particular emulsion example therein would meet the limitation, "from about 3% to about 6% by weight of an emulsifier **comprising** a cetyl dimethicone copolyol" (see below "Response to Argument" for further discussion).

Hence, the claimed range 3-6% lies inside ranges disclosed by the prior art. Thus, a *prima facie* case of obviousness exists. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See also MPEP 2144.05.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative, since sun screening agent and a preservative broadly, are known to be used in the water-in-oil emulsion composition according to Stepniewski et al. The particular sun screening agent, octyl methoxycinnamate, and phenoxyethanol, propyl paraben and methyl paraben as preservatives are well-known in the art to be used in personal care or conditioning human skin, hair or nails compositions Therefore, one of ordinary skill in the art would have reasonably expected that a known and art-recognized sun screening agent, octyl methoxycinnamate, and preservatives such as phenoxyethanol, propyl paraben and methyl paraben, would have the same or substantially similar usefulness as other sun screening agents and preservatives in water-in-oil emulsion compositions of Stepnieski et al.

Moreover, it has been well settled that recitation of an inherent property of a composition, e.g., the inherent stability of composition, will not further limit claims drawn to a composition.

Response to Argument

Applicant's arguments filed May 27, 2005, with respect to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al. (US 5,599,533) in view of Rapaport (US 5730991) and Dorogi et al. (US 5882661) of record in the previous Office Action have been considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art.

Applicant asserts that "[t]he combination of Stepniewski et al., Rapaport, and Dorogi et al. does not render the present inventive compositions obvious." and " Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%." and "Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%".

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145. In this case, the motivation to combine the teachings of the prior art cited herein, to make the present invention is seen since these references have provided knowledge of those skilled in art and nature of problem solved. In particular, the teachings of Stepniewski et al., that the particular emulsifier or surfactant, **cetyl dimethicone copolyol** in 0.5% by weight is used in the particular composition example therein.

Note that the instant claims, i.e., claim 1, are **not** limited to from about 3% to about 6% by weight of a cetyl dimethicone copolyol, since the limitation recited in claim 1 is "from about 3% to about 6% by weight of an emulsifier **comprising** a cetyl dimethicone copolyol". Note that the transitional phrases "comprising" is employed in the instant claimed emulsifier. The transitional term "comprising" is inclusive or open-ended and does not exclude additional and unrecited elements. See MPEP 2111.03.

Thus, this limitation can be interpreted as an emulsifier comprising a cetyl dimethicone copolyol together with additional and unrecited ingredients having about

3% to about 6% by weight, but a cetyl dimethicone copolyol alone having about 3% to about 6% by weight is not required by this limitation. Therefore, it is irrelevant whether the reference includes those features or not.

The combined teachings of the cited references have provided knowledge of those skilled in art and nature of problem solved. The claimed invention is obvious in view of the prior art.

Applicant's declaration under 37 CFR 1.132, submitted May 27, 2005, has been considered but is not persuasive to overcome the rejections made under 35 U.S.C. 103(a) for the following reasons. Note that Example 1-2 in the specification (page 16-20) shows the particular formulation with specific ingredients and amounts. The scope of the showing must be commensurate with the scope of the claims. *In re Coleman*, 205 USPQ 1172; *In re Greenfield*, 197 USPQ 227; *In re Lindener*, 173 USPQ 356; *In re Payne*, 203 USPQ 245. Thus, the evidence in the example herein is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the ingredients in the claimed composition. Moreover, Example 1-2 in the specification employs cetyl dimethicone copolyol in 4% by weight.

More importantly, the specification and declaration provide no clear and convincing factual evidence of nonobviousness or unexpected results, i.e., testing data for the claimed compositon herein over the prior art, since they provides no side-by-side **comparison** with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

Therefore, the declaration is ineffective to rebut the prima facie case herein.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
August 10, 2005